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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/827,219	04/05/2001	William Michael Bondy	CE08311R	6206

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MOTOROLA, INC.
1303 EAST ALGONQUIN ROAD
IL01/3RD
SCHAUMBURG, IL 60196

EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/827,219

Applicant(s)

BONDY ET AL.

Examiner

Ovidio Escalante

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1,3-13,15,16,18-20,22-34,26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Dikmen US Patent 6,549,613.

Regarding claim 1, Dikmen teaches a method for providing surveillance within a communication network, (abstract), the communication network providing communication services for a subscriber, (col. 1, line 43 - col. 2, line 2), wherein the subscriber accesses the communication network via an access network, (col. 3, lines 5-34), the method comprising the steps of:

receiving a request for surveillance services from a requesting agency, (col. 3, line 60-63; subscribers that are lawfully authorized for initiating electronic surveillance will have a trigger in the network that will be initiated when a trigger event occurs);

receiving trigger information associated with surveillance services in response to a trigger event, (col. 3, line 60-col. 4, line 4);

generating a duplicate of call information associated with a surveillance target in response to the trigger information, (col. 3, lines 18-22); and

transmitting the duplicate of call information to the requesting agency, (col. 3, lines 18-34; col. 4, lines 62-67).

Regarding claims 3 and 28, Dikmen teaches wherein the trigger event comprises one of a registration, a call connection, a call termination, and a service invocation, (col. 3, line 60 - col. 4, line 4).

Regarding claims 4 and 29, Dikmen teaches wherein the service invocation comprises a conference call, (col. 5, lines 46-63).

Regarding claims 5,15,19,23 and 26, Dikmen teaches wherein the access network comprises a radio access network, (col. 1, lines 27-29).

Regarding claim 6, Dikmen teaches a communication network providing communication services for a subscriber, (abstract; col. 1, line 43-col. 2, line 2; col. 3, lines 5-34), the communication network comprising:

an access server, the access server providing an interface between the communication network and an access network, (figs. 1 and 5; col. 1, lines 49-59; col. 3, line 8-23, 60-col. 4, line 4);

a relay client element interfaced with the access server, the relay client providing communications delivery services within the communication network, (col. 3, lines 18-34; fig 2);

a surveillance server, the surveillance server being interfaced with the relay client, (fig. 1; col. 3, line 58-col. 4, line 4); and

a gateway element, the gateway element linking the communication network to an associated network, (fig. 1; col. 3, lines 18-34);

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wherein responsive to the surveillance server, the relay client generates a duplicate of call information to the gateway element for communication to the associated network, (col. 3, lines 18-22; col. 4, lines 62-67).

Regarding claims 7,18 and 22, Dikmen teaches wherein the call information comprises one of bearer data and call signaling data, (col. 6, lines 1-14).

Regarding claim 8, Dikmen teaches wherein the relay client comprises a conference feature server, (col. 5, lines 46-63).

Regarding claim 9, Dikmen teaches wherein the surveillance server is part of a core network, (fig. 1).

Regarding claim 10, Dikmen teaches wherein the core network comprises a packet data network, (col. 3, lines 5-34).

Regarding claim 11, Dikmen teaches wherein the core network further comprises a feature server, and wherein the surveillance server is interfaced with the feature server, (col. 3, lines 5-34).

Regarding claim 12, Dikmen teaches wherein the feature server comprises a profile server, (col. 4, lines 6-42).

Regarding claim 13, Dikmen teaches a subscriber information database, and wherein the subscriber information database includes a data structure including subscriber surveillance data, (col. 4, lines 6-43).

Regarding claim 16, Dikmen teaches in a communication network providing communication services for a subscriber, (abstract), wherein the subscriber accesses the communication network via an access network, and wherein a server operates in accordance with

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a computer program embodied on a computer-readable medium for providing surveillance within the communication network, (col.1, line 43-col. 2, line 2; col. 3, lines 5-34), the computer program comprising:

a first routine that directs the server to receive a request for surveillance services from a requesting agency, (col. 3, lines 60-63; subscribers that are lawfully authorized for initiating electronic surveillance will have a trigger in the network that will be initiated when a trigger event occurs);

a second routine that directs the server to receive trigger information associated with the subscriber, (col. 3, line 60-col. 4, line 4);

a third routine that directs the server to generate a duplicate of call information associated with the subscriber in response to the trigger information, col. 3, lines 18-22); and

a fourth routine that directs the server to transmit the duplicate of call information to the requesting agency, (col. 3, lines 18-34; col. 4, lines 62-67).

Regarding claim 20, Dikmen teaches a method for providing surveillance within a communication network, (abstract), wherein the communication network providing communication services for a subscriber, (col. 1, line 43-col. 2, lines 5-34), and wherein the subscriber accesses the communication network via an access network, (col. 3, lines 5-34), the method comprising the steps of:

receiving a request for surveillance services from a requesting agency, (col. 3, lines 60-63);

receiving an authentication message for the request, (col. 3 lines 5-34);

receiving trigger information associated with surveillance services in response to a trigger event, (col. 3, lines 60-col. 4, line 4); and

transmitting a surveillance message to a core network in response to the trigger information, (col. 3, lines 18-22), the surveillance message includes information for generating a duplicate of call information associated with the subscriber, (col. 3, lines 18-22), wherein the core network generates and transmits the duplicate of call information to the requesting agency, (col. 4, lines 62-67).

Regarding claim 24, Dikmen teaches a communication network for providing communication services to a subscriber, (abstract), wherein the subscriber accesses the communication network via an access network, (col. 1, line 43-col. 2, line 2), the communication network comprises:

a core network, the core network including an access server for interfacing the core network with the access network and a gateway element linking the core network to an associated network, (col. 3, lines 5-34);

a surveillance server, the surveillance server including an interface with the core network, (fig. 1; col. 3, line 58-col. 4, line 4),

wherein upon receipt of a request for surveillance services by the core network via the gateway element, the core network is responsive to the surveillance server for providing surveillance services to a services requesting agency via the gateway element, (col. 3, lines 5-34).

Regarding claim 27, Dikmen teaches in a communication network providing communication services for a subscriber, (abstract), wherein the communication network

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providing communication services for a subscriber, and wherein a server operates in accordance with a computer program embodied on a computer-readable medium for providing surveillance within the communication network, (col. 1, lines 49-59) the computer program comprising the steps of:

a first routine that directs the server to receive a request for surveillance services from a requesting agency, (col. 3, lines 60-63; subscribers that are lawfully authorized for initiating electronic surveillance will have a trigger in the network that will be initiated when a trigger event occurs);

a second routine that directs the server to receive an authentication message for the request, (col. 3, line 60-col. 4, line 4);

a third routine that directs the server to receive trigger information associated with surveillance services in response to a trigger event, (col. 3, line 60-col. 4, line 4);

a fourth routine that directs the server to transmit a surveillance message to a core network in response to the trigger information, (col. 3, lines 18-34) the surveillance message includes information for generating a duplicate of call information associated with the subscriber, wherein the core network generates and transmits the duplicate of call information to the requesting agency, (col. 4, lines 62-67).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 2,14,17,21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dikmen in view of Bertacchi US Patent 5,930,698.

Regarding claims 2,14,17, 21 and 25, while Dikmen teaches of trigger information associated with the surveillance services, Dikmen does not specifically teach wherein the trigger information associated with surveillance services comprises at least a requesting agency identifier nor does Dikmen teach s wherein the surveillance server is interfaced to an authentication authority element and the authentication authority element authenticates the request for surveillance services from the requesting agency.

Bertacchi teaches of a method for sending duplicate call information to a Law Enforcement Agency. Bertacchi further teaches of a trigger information associated with surveillance services comprising a requesting agency identifier (col. 1, lines 52-63) and wherein a surveillance server is interfaced to an authentication authority element and the authentication authority element authenticates the request for surveillance services form the requesting agency, (col. 1, lines 57-61; col. 4, lines 54-61).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Dikmen by including an agency identifier and an

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authentication authority for authenticating the request as taught by Bertacchi so that the system can verify whether the call can be lawfully monitored by the authorized agency.

Conclusion

6. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

or faxed to:

(703) 872-9306, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262. The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group is (703) 872-9306.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [fan.tsang@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante
Examiner
Group 2645
January 26, 2004

FAN TSANG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', written over the printed name and title.